

REMARKS

Claims 1, 3-6, 8-22, 25, 26, and 28-38 are pending in the application. All of the claims have been rejected by the Examiner under Section 103. The Examiner has renewed arguments previously made in reliance on the same cited prior art references. Applicant traverses the rejection based on arguments and legal analysis previously of record, previously submitted objective evidence of nonobviousness and the newly submitted additional objective evidence of nonobviousness. Applicant respectfully urges the Examiner to withdraw the rejection.

35 U.S.C. § 103(a) REJECTION OF CLAIMS 1, 14, 19-22, 25, 28, 33-35, 37 AND 38 OVER BOBRICK IN VIEW OF MARSHALL

The Examiner rejected claims 1, 14, 19-22, 25, 28, 33-35, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Bobrick in view of U.S. Patent No. 1,625,041, issued to Marshall. Applicant respectfully traverses this rejection. In order to establish obviousness, *all* of the limitations in the claims must be found in two or more prior art references and there must be some motivation to combine *contained in the prior art* teaching or suggesting combination to achieve the claimed invention.

Applicant asserts that no evidence has been presented in the rejection showing either all of the elements or any teaching or suggestion to combine prior art references to achieve the claimed invention.

As discussed in prior responses neither Brobrick nor Marshall disclose a three dimensional marker having a “three-dimensional base extending downwardly and outwardly from the three-dimensional member, the base having a peripheral edge shaped to coincide with a scaled space envelope desired for movement of a wheelchair . . .” The Bobrick reference shows a two-dimensional transparent sheet. The Marshall reference shows figurines that include, in some cases, small bases bearing no relation to a space envelope desired for movement as defined by the figure. The bases in the Marshall reference are sized as small as possible to recreate a life-like depiction of an accident scene.

No evidence of a suggestion or motivation to combine the references has been provided. Brobrick provides no indication that a three dimensional figure is useful. Marshall provides no indication that the base of a figurine should be modified to approximate an envelope relating to the motion of the figurine. Marshall does suggest any use for the base other than possibly supporting the figurine. In the absence of any evidence of a suggestion or motivation to combine these references, a *prima facie* case of obviousness cannot be made.

35 U.S.C. § 103(a) REJECTION OF CLAIMS 3-6, 8, 9, 11-13, 15, 16, 26, 31, 32, AND 36 OVER BOBRICK, MARSHALL AND STANSBURY

The Examiner has cited the Stansbury reference as disclosing a roller measure device with a wand/handle member. Stansbury is a full size device not scaled for measuring distances on a plan. A combination of Stansbury with Bobrick and Marshall is not taught by the prior art. Bobrick and Marshall in fact teach away from combination. They are therefore insufficient to establish a *prima facie* case of obviousness.

In particular, both Bobrick and Marshall teach static elements whose primary function is to represent an object at a specific location. There is therefore no reason whatsoever to suggest fastening a rod to facilitate movement. Their static nature in fact teaches away from combination with any structure used to facilitate movement and visualization of movement. Bobrick is an overlay placed at particular locations. Bobrick is also a simple plastic sheet that can not conveniently have a push rod secured thereto.

The Marshall figurines are arranged to show an accident scene and are not moved around once in position. As stated in the summary, the figurines are placed to help communicate “where particular marker objects on a particular chart are to be located, so that the person at a distance may reproduce the scene upon a facsimile of the given chart.” Inasmuch as the figurines of Marshall are static, any wand or handle would simply interfere with the location of the figurines on the accident scene and provide no benefit in achieving the stated purpose of Marshall’s device.

**SECONDARY CONSIDERATIONS PRECLUDE REJECTION BASED ON 35 U.S.C. § 103(a)
OBVIOUSNESS**

In addition to the reasons set forth above, and forming an alternative basis for patentability, the claimed invention is not obvious in view of the evidence of secondary considerations submitted in the declarations of Duncan, Hartje, Tenenbaum, and Miller. These declarations contain the opinions of experts in the industry establishing the commercial success, long-felt need and failure of others as related to Applicant's invention.

The Examiner has objected in to the declarations as failing to convey objective evidence of commercial success, long-felt need and failure of others. More specifically, the Examiner has repeated the statement that the declarations fail to constitute "objective evidence" of nonobviousness. Applicant respectfully submits that the Examiner refusal to consider the declarations as "objective evidence" of the secondary considerations is improper.

The Supreme Court and Federal Circuit have long stated that commercial success, long-felt need and failure of others are objective evidence of nonobviousness that must be considered. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986) ("Objective evidence such as commercial success, failure of others, long-felt need, and unexpected results must be considered before a conclusion on obviousness is reached and is not merely 'icing on the cake.'"). 37 C.F.R. §1.132 specifically confirms that "[w]hen any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section." Accordingly, it is improper to state that the opinions and facts alleged in the affidavits are not evidence of nonobviousness.

Likewise, the Federal Rules of evidence allow for testimony of expert witnesses (FRE 702, 703) and opinion testimony (FRE 701) where the witness has a rational basis for the testimony. As stated in the submitted declarations, Susan M. Duncan, Sandra Hartje, Louis S. Tenenbaum and Michael Miller are qualified by knowledge, skill, education and experience to

testify regarding the state of the relevant industry. Their opinions therefore constitute legally sufficient evidence as opinions based on their expertise and as opinions based on their extensive personal knowledge of the industry.

Accordingly, under these principles, Applicant submits that the facts and opinions contained in the declarations must be given evidentiary weight in evaluating the obviousness of the claims. The declarations are entitled to weight for at least the following reasons: (1) the facts and opinions alleged therein are legally sufficient evidence establishing commercial success, long-felt need and failure of others; (2) evidence of commercial success, long-felt need and failure of others are, as defined by the Supreme Court and Federal circuit, *objective evidence* of non-obviousness and should therefore should not be dismissed as failing to provide objective evidence; and (3) 37 C.F.R. §1.132 specifically requires the submission of evidence in the form of sworn declarations such as those submitted by Applicant; accordingly the declarations are sufficient in terms of evidentiary weight and Applicant submits sufficient to establish nonobviousness.

An objective evaluation confirms that submitted declarations constitute compelling evidence establishing commercial success, long felt need and the failure of others.

With respect to evidence regarding commercial success, the Examiner asserted that the declarations fail to provide “objective evidence” that Applicant’s commercial success was not due to heavy promotion or shift in advertising or that the number of unit sales is considered to be significant given the industry. Applicant respectfully traverses the Examiner’s position.

First, Applicant is not required to prove a negative or, in other words to prove that commercial success of the patented invention is not due to factors other than the patented features. As explained by the Federal Circuit:

A patentee is not required to prove as part of its prima facie case that the commercial success of the patented invention is not due to factors other than the patented invention. It is sufficient to show that the commercial success was of the patented invention itself. A requirement for proof of the negative of all

imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.

Demaco Corp. v. F. Von Langsdorff Licensing, Ltd., 851 F.2d 1387, 1394 (Fed. Cir. 1988). Rather, to make out a *prima facie* case of nonobviousness, Applicant is required to show only that commercial success was of the patented invention itself or, in other words, of a product embodying the invention. *Demaco*, 851 F.2d at 1394; *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 719 (Fed. Cir. 1991).

Second, as stated in the Duncan Declaration, the commercial success of the invention in fact occurred in the absence of heavy advertising or promotion. Ms. Duncan testified that the sales were not due to “any significant promotion or advertising of the Visualizer Set, let alone heavy promotion or advertising.” (Duncan Dec. p. 4, lns. 21-22.) Ms. Duncan further testified that over 200 units of the invention have been sold in a very small market of professionals, amounting to 100% of the market for such products. (Duncan Dec. p. 4., lns. 4-19.) These facts establish both the number of units sold and their market share. The nexus between the patented features and the commercial success is established by the fact that the product sold embodied the claimed invention. *Demaco*, 851 F.2d at 1392-93. As is apparent from the figures submitted with the Duncan Declaration, the device sold embodies the claim limitations. Accordingly, the facts alleged in the Duncan Declaration, together with the declarations of the third parties, adequately establish commercial success of the invention.

Likewise, the facts alleged in all submitted declarations demonstrate long-felt need and the failure of others, which evidence further establishes the patentability of Applicant’s invention. By way of example, Hartje testifies that professionals in the relevant industry need to visualize the movement of disabled people and that prior systems are ineffective in aiding in the visualization of movement. (Hartje Dec. p. 2, lns 5-18). Tenenbaum states the objective fact that prior systems do not aid in the visualization of movement in three dimensions. (Tenenbaum Dec. p. 2, lns. 6-18). Miller points out specific facts regarding the deficiencies of prior systems,

namely, their "static nature" that limits their usefulness in showing movement. (Miller Dec. p. 2, Ins. 2-12). Susan M. Duncan as the inventor and manufacturer of the invention alleges specific objective facts, among them, the number of units sold and the size of the relevant market. (Duncan Dec. p. 4, Ins. 4-20). Duncan further alleges facts relating to the marketing and sale of the invention (Id. p. 4, Ins. 20-26).

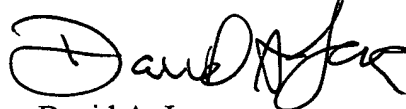
Applicant therefore respectfully submits that the extensive evidence of secondary considerations precludes rejection based on 35 U.S.C. § 103(a) obviousness.

CONCLUSION

Applicant submits that the claims are patentable over the prior art. Accordingly, Applicant respectfully requests reconsideration of the application and allowance of the claims. The Examiner is invited to contact the undersigned should direct communication on this matter be deemed helpful to facilitate progression of the case.

Respectfully submitted,

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